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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/235,155	01/22/1999	JOSHUA SUSSER	SUN-P3710	5107

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EXAMINER

OPIE, GEORGE L

ART UNIT

PAPER NUMBER

2126

DATE MAILED: 03/14/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

2

**Office Action Summary**

Application No.

09/235,155

Examiner

George L. Opie

Applicant(s)

Susser, et al.

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 25-49 is/are pending in the application.
- 4a) Of the above claim(s) ☐ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ☐ is/are allowed.
- 6) ☒ Claim(s) 1 and 25-49 is/are rejected.
- 7) ☐ Claim(s) ☐ is/are objected to.
- 8) ☐ Claim(s) ☐ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ☐ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ☐ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
  2. ☐ received in Application No. (Series Code / Serial Number) ☐.
  3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ☐.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ☐.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: ☐.

Art Unit: 2126

**DETAILED ACTION**

This Office Action is responsive to Applicant's 21 January 2003 Amendment. Claims 1 and 25-49 are currently pending and constitute the entire set of claims under consideration.

1. Request for copy of Applicant's response on floppy disk:  
Please help expedite the prosecution of this application by including, along with your amendment response in paper form, an electronic file copy in WordPerfect, Microsoft Word, or in ASCII text format on a 3½ inch IBM format floppy disk. Please include all pending claims along with your responsive remarks. Only the paper copy will be entered -- your floppy disk file will be considered a duplicate copy. Signatures are not required on the disk copy. The floppy disk copy is not mandatory, however, it will help expedite the processing of your application. Your cooperation is appreciated.
2. Claim Rejections - 35 U.S.C. § 112  
The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 38 and 42 are rejected as depending on cancelled claims.
4. The U.S. Patents used in the art rejections below have been provided as text documents which correspond to the U.S. Patents. The relevant portions of the text documents are cited according to page and line numbers in the art rejections below. For the convenience of Applicant, the cited sections are highlighted in the *text documents*. Consistent with Office procedure, the U.S. Patents corresponding to the *text documents* are also included with this action.
5. Claim Rejections - 35 U.S.C. § 103  
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2126

6. Claims 1 and 25-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Admitted Prior Art, background of application (APA) in view of De Jong (U.S. Patent 5,802,519).

As to claim 37, the APA teaches a method of permitting access to information on a small footprint device from a first program module to a second program module (information can be retrieved from a smart card using a card acceptance device) separated by a context barrier (standards for permitting separate execution contexts to operate on a smart card).

The APA does not explicitly disclose the additional limitations detailed below.

De Jong (p12 51-55) teaches a data exchange system for smart cards comprising a step of creating a context (interaction context) having access to all program modules without context barrier constraints (open any of the other applications).

It would have been obvious to combine De Jong's teachings with the APA because the context mechanism defined by De Jong (p6 23-25) "leads to a wider range of smart card use" and, thus provides more features/services for users.

As to claim 38, De Jong teaches a supercontext (management interaction context", p4 47-53). It would have been obvious to combine De Jong's teachings with the APA as modified because the management interaction context would allow a user to employ any available terminal for updating the smart card data from the given terminal, thereby enabling the user to interface the card with other devices for portability and convenience.

As to claim 39, see the claim 37 discussion supra. The limitations in claim 39 are functionally equivalent to claim 37, with the additional limitation in claim 39 of permitting the context to access information of another program module across the context barrier. De Jong teaches context "interactions between data processing units 4,5", p8 50 – p9 2, which shows the accessing of other program modules across contexts. It would have been obvious to combine De Jong's system with the APA because the context mechanism defined by DeJong p6 23-25) "leads to a wider range of smart card use" and, thus provides more features/services for users.

As to claim 1, the APA teaches a small footprint device (smart cards) comprising:

- a. at least one processing element (processor)
  - b. memory (memory typically found on a smart card)
  - c. a context barrier (name space) for isolating program modules from one another using said memory and said processing element (multiple execution contexts ... provides a way to separate or isolate different program modules).
- The APA does not explicitly disclose the additional limitations detailed below.

Art Unit: 2126

De Jong teaches a data exchange system for smart cards and one context (interaction context, p12 51-55) having access to all program modules without context barrier constraints (open any of the other applications, Id.). It would have been obvious to combine De Jong's teachings with the APA because the context mechanism defined by De Jong (p6 23-25) "leads to a wider range of smart card use" and, thus provides more features/services for users.

As to claim 25, De Jong (p4 47-53) teaches the context (interaction context) is used for access to at least one program module across a context barrier (review and modify data stored in the device memory from a smart card terminal).

As to claims 26-27, De Jong p8 teaches the context barrier (functional separation) allocates separate name spaces for each program module (processing units 4-5) and the context can access at least two program modules even though they are located in different respective name spaces (interaction between a smart card and a terminal).

As to claims 28-29, see De Jong's teachings as referenced in the discussion of claims 26-7 above. The limitations in claims 28-29 are functionally equivalent to the limitations in claims 26-7, but for the substitution of "memory space" for the "name space" term. It would have been an obvious variation for one skilled in the art to provide this configuration of memory, because the interaction of programs from separate memory spaces facilitates connectivity for safe and effective interprocess communications.

As to claims 30-34, De Jong teaches security protocols for governing interactions with contexts, memory, and objects, p4 41-46, p5 13-21, and p8 50 – p9 2, and from this, one skilled in the art would have provided the recited security checks, as routine procedures for promoting process interactions while ensuring that the operations can be trusted as part of the system.

As to claims 35-36, note the rejections of claims 1 and 33 respectively. The limitations in claims 35-36 are the functional equivalents of claims 1 and 33, with the difference being that claims 35-36 are method claims and claims 1 and 33 are apparatus claims.

As to claim 40, see the claim 39 discussion supra.

As to claim 41, note the rejection of claim 1 above. Claim 41 is the same as claim 1, except claim 41 is a computer program product claim and claim 1 is an apparatus claim.

Art Unit: 2126

As to claim 42, "Official Notice" is taken that the use of a carrier wave as a memory medium is well known in the art (MPEP2144.03).

As to claim 43, note the rejection of claim 39 above. Claim 43 is the same as claim 39, except claim 43 is a computer program product claim and claim 39 is a method claim.

As to claim 44, see the claim 42 rejection.

As to claims 45-46, note the rejections of claims 37 and 39 respectively. Claims 45-46 are the same as claims 37 and 39, except claims 45-46 are computer program product claims and claims 37 and 39 are method claims.

As to claim 47, see the claim 37 discussion supra. The claim 47 limitations are basically the same as claim 37, but for the addition in claim 47 of the recitation regarding the transmission of code from a server. Network communications from servers are notoriously well known, and thus transmitting the subject method/code would have obviously followed in this context.

As to claims 48-49, see the discussion of claims 39-40 supra. Claims 48-49 are means-plus-function claims that correspond to the claims 39-40 methods.

## **7. Response to Applicant's Remarks:**

Applicant argues (claim 1) that De Jong's teachings do not meet the limitation of "one context having access to all program modules without context barrier constraints." Despite Applicants assertions, DeJong's "interaction context" reads-on the claimed "one context having access to all program modules without context barrier constraints." De Jong (p12 51-55) clearly indicates that the "interaction context" has access to all program modules "open any of the other applications". The reference shows that the interaction context can enter any other module and use its data/methods. For example, De Jong describes a "management interaction context" p4 47-53, that facilitates access/review of modules/data on a card from a terminal device, i.e. "a smart card holder could be allowed to modify his PIN at any smart card terminal which provides an appropriate interface." De Jong's context interaction system does meet the one context able to access modules without barrier constraints as broadly claimed.

In considering the limitation of a "context having access to all program modules" across context barriers, it is noted that Applicant uses terminology that has broad meaning in the art, and thus requires a broad interpretation of the claims in determining patentability of the disclosed invention. Although the claims are

Art Unit: 2126

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant should set forth claims in language that clearly, distinctly, unambiguously and uniquely define the invention. The fact that Applicant has not narrowed the definition/scope of the current claims implies that Applicant intends an extensive coverage breadth of the claims, which is met by the APA and De Jong as presented in the rejections above.

The scope of the claimed "context" accessing any module "without context barrier constraints" clearly transcends the narrow scope that Applicant attempts to impute through argument. Claimed subject matter, not the specification is the measure of the invention. The concept of a "context having access to all program modules" is clearly subject to a broad interpretation, as detailed in the rejections maintained above. Consequently, the context accessing program modules without context barrier constraints, in the manner recited in the pending claims does not constitute a non obvious improvement over the prior art.

Applicant's arguments have been fully considered, but are deemed to be unpersuasive. For the reasons detailed above, the claims are judged to be obvious under 35 USC § 103.

#### **8. Contact Information:**

##### **PTO Policy for Facsimile Submissions:**


- ☐ AFTER-FINAL faxes must be signed and sent to (703) 746-7238.
- ☐ OFFICIAL faxes must be signed and sent to (703) 746-7239.
- ☐ NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

- ☐ Hand-delivered responses should be brought to Crystal Park Two, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Art Unit: 2126

- ☐ Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at **(703) 305-9600**.
- ☐ Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Opie at (703) 308-9120 or via e-mail at *George.Opie@uspto.gov*. Internet e-mail should not be used where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the Applicant. Sensitive data includes confidential information related to patent applications.

  
ST. JOHN COURTENAY III  
PRIMARY EXAMINER